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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,380	11/24/2000	Krister Hansson	TTP 31349	3719

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EXAMINER

GARLAND, STEVEN R

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,380

Applicant(s)

HANSSON ET AL.

Examiner

Steven R Garland

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, line 3, the term "and" is used. It appears that the use of the term "and" is misdescriptive and the term "or" should be used. Note page 5, lines 10-13. Claim 20 has a similar problem.

In the rejections it is assumed that the word "or" was intended.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,3,4, 7-13,17,21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mckee 5,568,391.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct layout using a diagram and instructions that the desired artistic rendering is achieved.

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Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, etc. See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

In response to applicant's arguments, Mckee teaches that the edges are suitable for joining in configurations such as edge to edge joining. Note the abstract. Secondly when the sections are arranged to produce the overall pattern the edges must be suitable for joining otherwise the overall design pattern would not produced if the edges can not be joined such as in the extreme instance of a curved 3 dimensional surface.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2,5,6,14,15,16,19,24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mckee 5,568,391.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct layout using a diagram and instructions that the desired artistic rendering is achieved. Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, plastic tiles (polymer), molding, etc. See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

Mckee while teaching the use of printed tiles does not specifically use them or go into details about segmentation of the border region since this is a function of the decor being implemented.

It would have been obvious to one of ordinary skill in the art to modify Mckee to allow the use of printed tiles for ease in manufacture.

Further it would have been obvious to one of ordinary skill in the art to modify Mckee to allow segmentation of the border region and choice in decor being applied to the border region so that the selected artistic rendering could be accomplished.

In response to applicant's arguments, Mckee teaches that the edges are suitable for joining in configurations such as edge to edge joining. Note the abstract. Secondly when the sections are arranged to produce the overall pattern the edges must be suitable for joining otherwise the overall design pattern would not be produced if the edges can not be joined such as in the extreme instance of a curved 3 dimensional surface. Further the rejected claims do not require the use of tongue and grooves joining as applicant appears to argue.

In regards to the printing arguments, Mckee in col. 3, lines 59-60 does teach cutting tiles with a device similar to an ink jet printer, but in lines 60-63, Mckee teaches dye or glaze using such as a system and provides other details in col. 15, lines 21-47, but simply fails to use the term printing. Also Mckee teaches printing patterns on tiles in col. 1, lines 41-63.

8. Claims 2,6,14,15,16,19,24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mckee 5,568,391 in view of Newton et al. 6,504,559.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct

layout using a diagram and instructions that the desired artistic rendering is achieved.

Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, plastic tiles (polymer),etc. See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

Mckee while teaching the use of printed tiles does not specifically use them. Even assuming that the process taught by Mckee in col. 15, lines 21-47, is not "printing" on tiles.

Newton et al. teaches printing a pattern on a tile. See col. 2, lines 44-52; col. 3, lines 7-20; col. 4, lines 19-27; and col. 7, lines 55-62.

It would have been obvious to one of ordinary skill in the art to modify Mckee in view of Newton to allow the use of printed tiles for ease in manufacture and the production of small production runs.

9. Claims 18,20,22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mckee 5,568,391 in view of Chen et al. 6,617,009.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct

layout using a diagram and instructions that the desired artistic rendering is achieved. McKee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, plastic tiles (polymer),etc. See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

McKee however does not teach the use of tongue and grooved elements or providing a protective layer by spray coating, curtain coating etc. McKee does teach the use of a protective coating but requires that coating element be required to withstand high temperatures.

Chen et al. teaches the use of tongue and grooved elements and applying a protective coating without the use of high temperatures. See col. 3, lines 1-8; col. 6, lines 7-22; and col. 11, lines 41-67.

It would have been obvious to one of ordinary skill in the art to modify McKee in view of Chen and use tongue and grooved elements for ease in keeping the surface flat and also to provide a protective coating by coating a plastic tile if the tile can not stand high temperatures to prevent damage to the surface.

10. Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKee 5,568,391 in view of Newton et al. 6,504,559 and Chen et al. 6,617,009.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct layout using a diagram and instructions that the desired artistic rendering is achieved. Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, plastic tiles (polymer),etc. See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

Mckee while teaching the use of printed tiles does not specifically use them. Even assuming that the process taught by Mckee in col. 15, lines 21-47, is not "printing" on tiles.

Newton et al. teaches printing a pattern on a tile. See col. 2, lines 44-52; col. 3, lines 7-20; col. 4, lines 19-27; and col. 7, lines 55-62.

It would have been obvious to one of ordinary skill in the art to modify Mckee in view of Newton to allow the use of printed tiles for ease in manufacture and the production of small production runs.

Mckee and Newton however do not teach the use of tongue and grooved elements or providing a protective layer by spray coating, curtain coating etc. Mckee

does teach the use of a protective coating but requires that coating element be required to withstand high temperatures.

Chen et al. teaches the use of tongue and grooved elements and applying a protective coating without the use of high temperatures. See col. 3, lines 1-8; col. 6, lines 7-22; and col. 11, lines 41-67.

It would have been obvious to one of ordinary skill in the art to modify Mckee and Newton in view of Chen and use tongue and grooved elements for ease in keeping the surface flat and also to provide a protective coating by coating a plastic tile if the tile can not stand high temperatures to prevent damage to the surface.

11. Claims 1,3,4, 7-13, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerber 5,443,680.

Gerber teaches input of an overall decor; dimensions of the surface to be covered; segmentation; use of various sizes and shapes of tiles; use of a scanned image or image stored in memory; coloring the tiles; labeling; shading; cutting, printing a copy of the overall pattern See the abstract; figures; col. 1, lines 39-62; col. 2, lines 1-67; col. 4, lines 19-37 and 57-68; col. 6, lines 34-41; and col.9, line 18 on.

In response to applicant's arguments, the edges of Gerber are suitable for joining other wise the overall pattern can not be formed. Further the edges are not required to be tongue and grooved as applicant appears to argue.

12. Claim 2,6,14, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber 5,443,680 as applied to claims 1,3,4, 7-13, and 23 above, and further in view of Newton et al. 6,504,559.

Gerber teaches input of an overall decor; dimensions of the surface to be covered; segmentation; use of various sizes and shapes of tiles; use of a scanned image or image stored in memory; coloring the tiles; labeling; shading; printing a copy of the overall pattern, use of a polymer (col. 12, lines 55-65). See the abstract; figures; col. 1, lines 39-62; col. 2, lines 1-67; col. 4, lines 19-37 and 57-68; col. 6, lines 34-41; and col.9, line 18 on.

Gerber however does not teach printing the pattern.

Newton et al. teaches printing a pattern on a tile. See col. 2, lines 44-52; col. 3, lines 7-20; col. 4, lines 19-27; and col. 7, lines 55-62.

It would have been obvious to one of ordinary skill in the art to modify Gerber in view of Newton and print a pattern on the tiles. This would allow ease in forming the pattern on the tiles and improve the sharpness of the images.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on 703-308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

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SRG
Steven R Garland
Examiner
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L. P. Picard

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